

b.) Remarks

The claims have been amended in order to recite the present invention with the specificity required by statute and for better idiomatic format. No new matter has been added.

Claim 25 is objected to only for being dependent on a rejected base claim, and would be allowable if rewritten in independent form. The Examiner's kind assistance in expediting the prosecution of this application by examining separately the subject matter of Applicants' dependent claims is gratefully acknowledged.

Claims 1, 6-19, 21-28, 38, 39, 43 and 44 are rejected under 35 U.S.C. §112, first paragraph, because first, the Examiner contends the language "adult bone marrow-derived stem cell, wherein said stem cell can differentiate into at least two cells" is new matter. As best understood, the basis for the objection is that the claims encompass stem cells which differentiate into as few as only two cells. Frankly speaking, such is not at all well-understood; this exact language is utilized throughout the specification. See, e.g., page 7, lines 13-21, etc.

"First paragraph of 35 U.S.C. §112 does not require a specific example of everything within scope of broad claim in application wherein there are specific examples of what seems to be preferred embodiment...where there is clear disclosure of a broader invention." *In re Andersen*, 176 USPQ 331 (CCPA 1973).

Accordingly, withdrawal or clarification of that basis of rejection is respectfully requested.

Additionally, the Examiner also contends that

it would constitute undue experimentation to test the breadth of any potential isolated cell to see if it meets the requirements of the [dependent] claims (emphasis added).

Respectfully submitted, the Examiner's concern is off-point. "Undue experimentation" is prohibited in order to ensure the invention can be made by the skilled artisan, and is not concerned with determining infringement. In that regard, the subject matter of the independent claims can be made with minimal experimentation. As to the features noted by the Examiner in the dependent claims, each is recited definitely and further limits the subject matter of their respective antecedent claims. Such is all that is required by 35 U.S.C. §112. If some experimentation is necessary¹ to determine whether or not the dependent claim is infringed as well, such is permitted under U.S. practice. *In re Angstadt*, 190 USPQ 214 (CCPA 1976); *Ex parte Chen*, 61 USPQ 2d 1025 (BPAI Aug 22, 2001).

Claims 1, 6-19, 21-28, 38, 39, 41, 43 and 44 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this regard, the Examiner contends the scope of "derived" is not clear from the specification. Although

¹ The level of which is not, by the way, undue in this art. However, if the Examiner's position is that the amount of experimentation is undue, then Applicants will promptly file a Declaration under Rule 132 evidencing that such is incorrect, upon notification thereof, in conformity with *In re Naquin*, 158 USPQ 317 (CCPA 1968).

Applicants respectfully submit “derived” is idiomatic in this art², solely in order to reduce the issues Applicants have amended the claims to clarify that the stem cell is --obtained-- from adult bone marrow. Additionally, as to claims 6-19, 21-28, 38, 39, 41, 43 and 44, the Examiner correctly states the phrase “the cell” is unclear since claim 1 recites a stem cell and at least two other cells. In response, these claims have been amended to specify that the “cell” is the -- stem cell--. Accordingly, this rejection is overcome.

Claims 1, 6-19, 21-28, 38, 39, 41, 43 and 44 are rejected under 35 U.S.C. §102(b) as being anticipated by Klug, Juttermann, Shi, Young and Makino. This rejection is respectfully traversed. However, without belaboring the record, Applicants respectfully wish to point out that such has been addressed by the above amendment which now explicitly recites the source of the cell, e.g., provides a “specific limitation to where the cell is obtained”, as requested by the Examiner at page 8, lines 2-4 of the Office Action. Accordingly, this rejection is overcome as well.

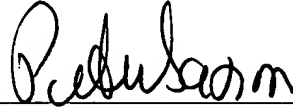
In view of the above amendments and remarks, Applicants submit that all of the claims are now in allowable condition. Reconsideration and allowance of this application is earnestly solicited.

Claims 1, 6-19, 21-28, 38, 39, 41, 43, 44, 47-63 and 78-91 remain presented for continued prosecution.

² Witness the 162 U.S. patents issued from 1996 to date containing the exact phrase “derived from a cell” in their claims. See, e.g., U.S. Patent Nos. 6,797,493 (claim 4), 6,420,111 (claim 46) and 5,384,394 (claim 1), etc.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

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